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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG OGG

Appeal 2010-004077
Application 10/677,829
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

An oral hearing was held on May 5, 2011.

STATEMENT OF THE CASE

Craig Ogg (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 14-27. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The invention relates to “postage usage, and more specifically to a system for choosing between a remote postage account and a local postage account.” Specification [0002].

Claim 14, reproduced below, is illustrative of the subject matter on appeal.

14. A method of accessing a remote postage account from a local postage evidencing device, comprising:
 configuring the local postage evidencing device to communicate with a plurality of vendors providing access to a plurality of remote postage accounts;
 connecting to a remote postage evidencing system via a local postage evidencing device, said local postage evidencing device having a local postage account;
 identifying a remote postage account administered by a selected vendor of said plurality of vendors on the remote postage evidencing system that is to be used to print postage on the local postage evidencing device;
 selecting a desired postage amount to be printed on the local postage evidencing device;
 reducing a balance on the remote postage account without transferring the value of the postage amount to the local account, thereby maintaining a same local postage account balance; and

¹ Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Jun. 22, 2009) and Reply Brief (“Reply Br.,” filed Nov. 2, 2009), and the Examiner’s Answer (“Answer,” mailed Sept. 2, 2009)

printing the desired postage amount on the local postage evidencing device.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Pierce	US 6,151,591	Nov. 21, 2000
Lee	US 5,742,683	Apr. 21, 1998
Eddy	US 5,812,400	Sep. 22, 1998
Willoughby	WO 02/093498 A2	Nov. 21, 2002

The following rejections are before us for review:

1. Claims 14-18, 20, 21, and 24-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pierce and Willoughby.
2. Claim 19 is rejected under 35 U.S.C. §103(a) as being unpatentable over Pierce, Willoughby, and Lee.
3. Claims 22 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pierce, Willoughby, and Eddy.

ISSUE

The issue is whether the cited prior art would lead one to “configure[e] [a] local postage evidencing device to communicate with a plurality of vendors providing access to a plurality of remote postage accounts” (claim 14).

FINDINGS OF FACT

We rely on the Examiner’s factual findings stated in the Answer (Answer 3-7). Additional findings of fact may appear in the Analysis below.

ANALYSIS

The rejection of claims 14-18, 20, 21, and 24-27 under 35 U.S.C. §103(a) as being unpatentable over Pierce and Willoughby.

Independent claim 14

The Examiner's position is that Pierce discloses all the claim limitations but for (1) "configuring the local postage evidencing device to communicate with a plurality of vendors providing access to a plurality of remote postage accounts" (claim 14), and (2) and "identifying a remote postage account administered by a selected vendor of said plurality of vendors on the remote postage evidencing system that is to be used to print postage on the local postage evidencing device" (claim 14). For these two steps, the Examiner relied on Willoughby. Answer 3-4. Given Pierce and Willoughby, the Examiner concluded that:

It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Willoughby so that a user can select another vendor if a particular remote postage provider suffers downtime or exits the industry (as taught by Willoughby; ¶ 0012). Moreover, this is merely a combination of old elements in which each would serve the same function as it did separately, and the addition of this feature to the method disclosed by Pierce could be implemented through routine engineering producing predictable results.

Answer 4.

The Appellant disagrees on the grounds that (a) the combination of Pierce and Willoughby does not disclose "configuring the local postage evidencing device to communicate with a plurality of vendors" (claim 14) (App. Br. 6-8; Reply Br. 3); (b) the combination of Pierce and Willoughby would not lead one of ordinary skill in the art to the claimed invention (App.

Br. 8-11; Reply Br. 3-4); and, (c) “the Office has failed to provide a plausible reason for why a person of ordinary skill would have been motivated to combine *Pierce* and *Willoughby*.” (App. Br. 11; Reply Br. 5).

We do not find these arguments persuasive as to error in the rejection.

In arguing that the combination of *Pierce* and *Willoughby* does not disclose “configuring the local postage evidencing device to communicate with a plurality of vendors,” the Appellant explains that *Willoughby* “discloses a system in which a user computer is configured to communicate only with a shipping system, and not a plurality of vendors as required by claim 14.” App. Br. 7. *See also* Reply Br. 3. “In other words, *Willoughby* discloses a system in which a user computer is configured to communicate with only a single entity, not a plurality of vendors.” App. Br. 7.

The difficulty with this argument is that the rejection is over the combination as a whole, not *Willoughby* alone. The Examiner found that *Pierce* “teaches a method of accessing a remote postage account from a local postage evidencing device” (Answer 3). This finding has not been disputed. Accordingly, we take as accepted that *Pierce* discloses accessing a remote postage account from a local postage evidencing device. To one of ordinary skill in the art, remote postage accounts are presumably associated with and under the control of an entity, and it is generally known that vendors per se are among the entities known to have postage accounts. Thus, when given *Pierce*’s disclosure of a local postage evidencing device accessing a remote postage account, one of ordinary skill in the art would understand that that local postage evidencing device is configured to communicate with an entity such as a vendor providing access to a remote postage account. In evaluating such references, it is proper to take into account not only the

specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968). “A court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Thus, the question comes down to whether one of ordinary skill in the art would be led to a local postage evidencing device configured to communicate with “a plurality of vendors providing access to a plurality of remote postage accounts” (claim 14). In our view, one of ordinary skill in the art would be aware that various vendors with remote postage accounts exist and communicating with any one of them would simply be a matter of repeating what *Pierce* discloses; that is, configuring *Pierce*’s local postage evidencing device to communicate with another vendor. Merely duplicating *Pierce*’s remote account access such that another vendor provides access to a postage account would yield a local postage evidencing device configured to communicate with “a plurality of vendors providing access to a plurality of remote postage accounts” as claimed. Nothing unpredictable has been shown for repeating the familiar step *Pierce* discloses for a single entity in order to communicate with another. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 415-416.

In arguing that “the combination of *Pierce* and *Willoughby* would not lead one of ordinary skill in the art to the claimed invention,” the Appellant points out that *Pierce* and *Willoughby* cannot be combined. According to the Appellant, “the teachings of *Willoughby* cannot simply be substituted or added into the system of *Pierce* because the two systems are fundamentally

different.” App. Br. 8. The Appellant explains that the combination would not work nor function as claimed because, for example, “the vendors of *Willoughby* would not function as the asserted remote part of the network of *Pierce* because when a local PSD is attempting to utilize a remote account's funds, the shipping system API of *Willoughby* would attempt to meter the postage (which is the task of the local PSD of *Pierce*)” (App. Br. 10).

The difficulty with this argument is that the only issue is whether the cited prior art would lead one to “configure[e] [a] local postage evidencing device to communicate with a plurality of vendors providing access to a plurality of remote postage accounts”. The Examiner found that *Pierce* “teaches a method of accessing a remote postage account from a local postage evidencing device” (Answer 3) and this finding has not been disputed. Thus the question comes down to whether one of ordinary skill in the art would be led to take *Pierce*’s local postage evidencing device and configure it to communicate with “a plurality of vendors providing access to a plurality of remote postage accounts” (claim 14). That the Appellant acknowledges that *Willoughby* teaches “vendors” further supports the view (*see supra*) that it is generally known that vendors per se are among the entities known to have postage accounts. Given that knowledge, it would have been obvious to repeat *Pierce*’s configuring of the local postage evidencing device with a single vendor such that it communicates with another vendor. In that respect, the combination of *Pierce* and *Willoughby* would lead one of ordinary skill in the art to the claimed invention.

In arguing that “the Office has failed to provide a plausible reason for why a person of ordinary skill would have been motivated to combine *Pierce* and *Willoughby*,” the Appellant challenges the logical reasoning

underpinning the conclusion of obviousness stated in the Final Rejection: “it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the invention to incorporate the above teachings of Willoughby, so that a user can select another vendor if a particular remote postage provider suffers downtime.’ Final Action at 4.” App. Br. 11.

We are not persuaded by this argument because the Examiner furthermore also stated that “this [selecting another vendor] is merely a combination of old elements in which each would serve the same function as it did separately, and the addition of this feature to the method disclosed by Pierce could be implemented through routine engineering producing predictable results.” (Final Rejection 4 and Answer 4). For the reasons discussed above, we find the record supports finding that it would have been obvious to take Pierce’s local postage evidencing device and repeat the configuration with a single vendor such that it communicates with another vendor and thereby meet the claim limitation of “configuring the local postage evidencing device to communicate with a plurality of vendors” (claim 14).

The rejection of claim 14 is sustained.

Dependent claims 15-18, 20, 21, and 24-27

The Appellant argues only claim 25. App. Br. 12. According to the Appellant, claim 25 calls for “Internet-based postage service” and that is not met by Pierce’s disclosure of “a PSD attached to a host computer can be refilled through a network connection to a data center. App. Br. 12. This is not a persuasive argument. Given Pierce’s disclosure of refilling over a “network” and that the Internet is a known network, it would have been

obvious to use an “Internet-based postage service” as the means for achieving a refill over a network.

The rejection of claims 15-18, 20, 21, and 24-27 is sustained
The rejection of claim 19 under 35 U.S.C. §103(a) as being unpatentable over Pierce, Willoughby, and Lee.

The Appellant argued against the rejection of claim 19 for the same reasons used to argue against the rejection of claim 14. App. Br. 13. Accordingly, because we found them unpersuasive as to that rejection, we find them equally unpersuasive as to error in the rejection of claim 19.

The rejection of claims 22 and 23 under 35 U.S.C. §103(a) as being unpatentable over Pierce, Willoughby, and Eddy.

The Appellant argued against the rejection of claims 22 and 23 for the same reasons used to argue against the rejection of claim 14. App. Br. 13. Accordingly, because we found them unpersuasive as to that rejection, we find them equally unpersuasive as to error in the rejection of claim 19.

DECISION

The decision of the Examiner to reject claims 14-27 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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